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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/553,125	04/19/2000	Joseph M. Cannon	1298/OF148	3933

7590

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EXAMINER

GAUTHIER, GERALD

ART UNIT

PAPER NUMBER

2645

DATE MAILED: 07/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/553,125

Applicant(s)

CANNON ET AL.

Examiner

Gerald Gauthier

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 March 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. **Claim(s) 1** is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Regarding **claim(s) 1**, a single step claim, i.e., where a step recitation does not appear in combination with another recited element of step, is subject to an undue breadth rejection under 35 U.S.C. 112, first paragraph. In re Hyatt, 708 F.2d 712, 714-715, 218 USPQ 195, 197 (Fed. Cir. 1983) (A single step claim which covered every conceivable step for achieving the stated purpose was held nonenabling for the scope of the claim because the specification disclosed at most only those steps known to the inventor.). When claims depend on a recited property, a fact situation comparable to Hyatt is possible, where the claim covers every conceivable structure (steps) for achieving the stated property (result) while the specification discloses at most only those known to the inventor.

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3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

4. **Claim(s) 10** is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding **claim(s) 10**, lines 6-7 "a second ringing signal" is recited in the claim and nowhere in the limitation a first ring signal is mentioned. Therefore the subject matter is indefinite.

Claim(s) 11 and 12 are rejected for being dependent of the rejected **claim(s) 10**.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

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1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. **Claim(s) 1, 4, 7 and 10** are rejected under 35 U.S.C. 103(a) as being unpatentable over Knuth (US 5,646,979) in view of Goetcheus et al. (US 5,444,767).

Regarding **claims 1 and 4**, Knuth discloses a method for communicating an audio message between a calling telephone apparatus and a called telephone apparatus while the called telephone apparatus remains in an on-hook state, the calling telephone apparatus and the called telephone apparatus being connected to a telephone system (column 1, lines 6-10), the method comprising the steps of:

receiving a message during a silent interval following a ringing signal appearing at the called telephone apparatus (column 4, lines 11-21) [The line interface 8 detects the presence of the caller information receiving along the telephone line 4 between rings];

converting the digitized version of the audio message to an acoustic version thereof (column 4, lines 22-30) [The speech synthesizer converts the caller information signal to a speech signal to be send to the cordless telephone 14];

introducing the acoustic version to a speaker to produce an audible version of the audio message (column 4, lines 34-45) [The synthesized speech signal is supplied to the loudspeaker 48 of the cordless handset 44 in a ring/CID mode while the cordless phone is on hook].

Although, Knuth discloses receiving a signal message while the telephone is on hook but fails to disclose receiving a digitized version of the message.

However, Goetcheus, in the same field of endeavor, teaches receiving a digitized version of the audio message on the telephone line (FIG. 1 and column 3, lines 57-68).

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify the invention of Knuth using the calling party digitized audio messages as taught by Goetcheus.

This modification would enable the system of Knuth to receiving a digitized version of the message so that the resulting audio message would be similar in sound to the personalized audio message.

Regarding **claims 7 and 10**, Knuth discloses an apparatus for communicating an audio message between a calling telephone apparatus and a called telephone apparatus while the called telephone apparatus remains in an on-hook state, the calling

telephone apparatus and the called telephone apparatus being connected to a telephone system (column 1, lines 6-10), comprising:

a silence detector detecting a silent interval following a second ringing signal provided to the called telephone apparatus (column 4, lines 11-21) [The line interface 8 monitors the telephone line 4 to detect a silent interval between rings signals];

a receiver, responsive to the silence detector, receiving a message relating to a call from a calling telephone to the called telephone apparatus over a telephone line during the detected silent interval (column 4, lines 11-21) [The caller ID detector 12 receives the caller information from the line interface 8 which in turn supplies the information to the controller 16]; and

a digital-to-analog converter converting the message to an audio version thereof (column 4, lines 22-30) [The speech synthesizer 10 converts the caller information signal supplied by the controller 16]; and

a speaker responsive to the audio version to produce an audible version of the audio message (column 4, lines 34-45) [The synthesized speech signal is supplied to the loudspeaker 48 of the cordless handset 44 in a ring/CID mode while the cordless phone is on hook].

Although, Knuth discloses receiving a signal message while the telephone is on hook but fails to disclose receiving a digitized version of the message.

However, Goetcheus, in the same field of endeavor, teaches receiving a digitized version of the audio message on the telephone line (FIG. 1 and column 3, lines 57-68).

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify the invention of Knuth using the calling party digitized audio messages as taught by Goetcheus.

This modification would enable the system of Knuth to receiving a digitized version of the message so that the resulting audio message would be similar in sound to the personalized audio message.

9. **Claim(s) 2-3, 5-6, 8-9 and 11-12** are rejected under 35 U.S.C. 103(a) as being unpatentable over Knuth in view of Goetcheus as applied to **claim(s) 1, 4, 7 and 10** above, and further in view of Guercio et al. (US 6,373,925 B1).

Regarding **claims 2, 5, 8 and 11**, Knuth in combination with Goetcheus as applied to **claims 1, 4, 7 and 10** differ from **claims 2, 5, 8 and 11** in that it fails to disclose a signal identifying the calling party during a silent interval following a first ringing signal provided to the called telephone apparatus, whereby the called telephone apparatus is provided Caller ID information, in addition to the audio message.

However, Guercio teaches introducing a signal identifying the calling party (column 7, line 56 "the calling party information") during a silent interval (column 7, line 57 "between a first ring signal and a second ring signal") following a first ringing signal (column 7, line 57 "a first ring") provided to the called telephone apparatus, whereby the called telephone apparatus is provided Caller ID information, in addition to the audio

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message (column 7, lines 50-67) [The caller ID information is transmitted between the first and the second ringing cycles and the associated voice message is played back].

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify the invention of Knuth using the calling party announcement system as taught by Guercio.

This modification would enable the system of Knuth to improve a telephone answering method so that the user would receive the caller ID information before answering the call.

Regarding **claims 3, 6, 9 and 12**, Guercio teaches wherein the digitized version of the audio message is of sufficient duration to extend beyond a silent interval in which it begins (column 7, lines 50-67) [The store voice message may also be playback in place of subsequent ring signals].

Response to Arguments

10. Applicant's arguments with respect to **claims 1-12** have been considered but are moot in view of the new ground(s) of rejection.

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Conclusion

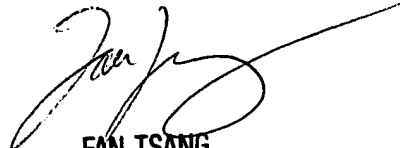
11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gerald Gauthier whose telephone number is (571) 272-7539. The examiner can normally be reached on 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on (571) 272-7547. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

GERALD GAUTHIER
PATENT EXAMINER
g.g.

July 11, 2005


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